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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,403	01/23/2004	Stephen M. Key	PA2644US	9494
22830	7590	09/20/2005	EXAMINER	
CARR & FERRELL LLP 2200 GENG ROAD PALO ALTO, CA 94303			OSELE, MARK A	
			ART UNIT	PAPER NUMBER
			1734	
DATE MAILED: 09/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,403

Applicant(s)

KEY, STEPHEN M.

Examiner

Mark A. Osele

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-14, 16, 20, 22-26, 28-30, 33, 35 and 39 is/are rejected.
- 7) ☒ Claim(s) 4-6, 15, 17-19, 21, 27, 31-32, 34, 36-38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>06/14/2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 7, 20, 33, and 39 rejected under 35 U.S.C. 103(a) as being unpatentable over Jespersen in view of Coulthard. Jespersen teaches that it is known to label a cylindrical object with a rotatable label comprising a base affixed directly to the container and a shell having a rotatable portion with a transparent window and top and bottom guide rails separated from the rotatable portion by severable lines of perforation. The top and bottom guide rails are glued to the container and the consumer breaks the lines of perforation to allow rotation of the rotatable portion which affords a view of indicia on the base layer or container itself (column 1, lines 11-31). Jespersen shows the instantly claimed limitations except for an electrostatic charge to the outer label.

Coulthard teaches that the outer, removable layer in a multi-layer display system can be adhered to the inner layer by an electrostatic charge (column 3, lines 11-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to bond the outer label of Jespersen to the inner layer using an electrostatic charge because Coulthard teaches that this allows for easy removal and replacement of an outer indicia bearing layer.

3. Claims 8, 13, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jespersen in view of Brombacher. Jespersen teaches that it is known to label a cylindrical object with a rotatable label comprising a base affixed directly to the container and a shell having a rotatable portion with a transparent window and top and bottom guide rails separated from the rotatable portion by severable lines of perforation. The top and bottom guide rails are glued to the container and the consumer breaks the lines of perforation to allow rotation of the rotatable portion which affords a view of indicia on the base layer or container itself (column 1, lines 11-31). Jespersen shows the instantly claimed limitations except for adhesive between the two labels.

Brombacher teaches that three glue dots between the layers of a multi-layer label system allow for repeated removal and replacement of the outer layer from the inner layer (column 3, line 62 to column 4, line 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the plurality of glue dots of Brombacher to hold the outer label of Jespersen to the inner label because Brombacher teaches that a consumer can easily remove and replace an outer label using this adhesive. Furthermore, it would have been obvious to one of ordinary skill in the art that the adhesive could be applied to either the inside of the outer layer or the outside of the inner layer because both accomplish adhesive between the layers.

4. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jespersen in view of Morgan and Brombacher. Jespersen teaches that it is known to

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label a cylindrical object with a rotatable label comprising a base affixed directly to the container and a shell having a rotatable portion with a transparent window and top and bottom guide rails separated from the rotatable portion by severable lines of perforation. The top and bottom guide rails are glued to the container and the consumer breaks the lines of perforation to allow rotation of the rotatable portion which affords a view of indicia on the base layer or container itself (column 1, lines 11-31). Jespersen shows the instantly claimed limitations except for a trailing end of the outer label overlaps a leading end of the outer label.

Morgan teaches that the trailing end of the outer label overlaps an adhesive coated leading end of the outer label (column 2, lines 32-47). It would have been obvious to one of ordinary skill in the art at the time the invention was made to bond the leading and trailing ends of the label of Jespersen because Morgan teaches that an outer label sealed this way can be easily removed.

Brombacher teaches that three glue dots between the layers of a multi-layer label system allow for repeated removal and replacement of the outer layer from the inner layer (column 3, line 62 to column 4, line 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the plurality of glue dots of Brombacher to hold the outer label of the references as combined to the inner label because Brombacher teaches that a consumer can easily remove and replace an outer label using this adhesive. Furthermore, it would have been obvious to one of ordinary skill in the art that the adhesive could be applied to either the inside of the outer

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layer or the outside of the inner layer because both accomplish adhesive between the layers.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-3, 8-9, 11-14, 16, 22-24, and 35 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-19 of U.S. Patent No. 6,086,697. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is obvious to supply labels with indicia so users will know what is in the container.

Regarding claims 16, 23, the method of applying a rotatable label creates the claimed rotatable label.

Regarding claims 8, 13, 22 it would have been obvious to one of ordinary skill in the art that the adhesive could be applied to either the inside of the outer layer or the outside of the inner layer because both accomplish adhesive between the layers.

Regarding claim 24, It would have been obvious to one of ordinary skill in the art at the time the invention was made to create a transparent portion on the outer label for viewing underlying indicia because claim 22 of U.S. Patent No. 6,086,697 teaches that this is advantageous.

7. Claims 7, 20, and 39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-19 of U.S. Patent No. 6,086,697 in view of Coulthard. Coulthard teaches that the outer, removable layer in a multi-layer display system can be adhered to the inner layer by an electrostatic charge (column 3, lines 11-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to bond the outer label of U.S. Patent 6,086,697 to the inner layer using an electrostatic charge because Coulthard teaches that this allows for easy removal and replacement of an outer indicia bearing layer.

8. Claims 10, 25-26, 28-29, and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-19 of U.S. Patent No. 6,086,697 in view of Morgan. Morgan teaches that the trailing end of the outer label overlaps an adhesive coated leading end of the outer label (column 2, lines 32-47). It would have been obvious to one of ordinary skill in the art at the time the invention was made to bond the leading and trailing ends of the label of U.S. Patent No.

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6,086,697 because Morgan teaches that an outer label sealed this way can be easily removed.

Regarding claim 26, It would have been obvious to one of ordinary skill in the art at the time the invention was made to create a transparent portion on the outer label for viewing underlying indicia because claim 22 of U.S. Patent No. 6,086,697 teaches that this is advantageous.

Regarding claim 29 it would have been obvious to one of ordinary skill in the art that the adhesive could be applied to either the inside of the outer layer or the outside of the inner layer because both accomplish adhesive between the layers.

9. Claim 33 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-19 of U.S. Patent No. 6,086,697 in view of Morgan as applied to claim 25 above and further in view of Coulthard.

Coulthard teaches that the outer, removable layer in a multi-layer display system can be adhered to the inner layer by an electrostatic charge (column 3, lines 11-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to bond the outer label of U.S. Patent 6,086,697 in view of Morgan to the inner layer using an electrostatic charge because Coulthard teaches that this allows for easy removal and replacement of an outer indicia bearing layer.

Allowable Subject Matter

10. Claims 4-6, 15, 17-19, 21, 27, 31-32, 34, 36-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments filed June 30, 2005 have been fully considered but they are not persuasive. The limitations in claims 7-8, 13, 20, 22, 29, 33, and 39 are not shown in the '697 Key patent. Regarding applicant's arguments against the Coulthard reference, one of ordinary skill in the art would understand that Coulthard shows a simple solution for adhering inner and outer film layers. Regarding applicant's arguments against Brombacher, one of ordinary skill in the art would appreciate that the releasable and readherable adhesive dots of Brombacher would allow a user to move the window in the outer label to a desired location and then press against the label to prevent it from moving while the underneath indicia is exposed. This would be important if a plurality of instructions are printed on the inner label, but only one is applicable to the particular user. Once that set of instructions is found, it would be helpful to maintain the window in a fixed position thereafter.

The remainder of the previous rejections are rescinded as the limitations in those claims show direct continuity to the '697 Key patent.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**MARK A. OSELE
PRIMARY EXAMINER**

September 19, 2005